

### REMARKS

The Office Action dated February 24, 2004, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto. Claims 1, 3, 6, 8, 13 and 20 have been amended to more particularly point out and distinctly claim the subject matter of the invention. No new matter has been added, and no new issues are raised which require further consideration and/or search. Claims 1-4 and 6-20 are respectfully submitted for consideration.

The Office Action notes that the objections to the specification and claim 6 have been withdrawn. Applicants note that the Response filed January 28, 2004 also included a replacement drawing sheet, but receipt of that replacement sheet has not been acknowledged. Acknowledgement of the replacement sheet, previously submitted, is respectfully requested.

First, Applicants respectfully assert that the Office Action of February 24, 2004, was improvidently made final. While the Office Action alleges that "Applicant's amendment necessitated the new ground(s) of rejection presented in the Office Action," Applicants note that claim 6 was not previously rejected under 35 U.S.C. §112, second paragraph. The prior amendment to claim 6 merely placed that claim in independent form and could not have necessitated new grounds of rejection. Because claim 6 was newly rejected under 35 U.S.C. §112, second paragraph, in the last Office Action, the Office Action should not have been made final. Withdrawal of the finality of the last Office Action is respectfully requested.

Applicants note that all of the previous-made prior art rejections of the claims have been withdrawn. Because the Office has now alleged that the “invention is impossible to implement,” the rejections were retracted, but the rejection were alleged to still hold “if the applicant meant that the steps were performed in a sequential manner.” Applicants respectfully assert that any such “ad hoc” rejections of the claims are improper and Applicants have not responded to such rejections and will only discuss the rejections actually made in the Office Action.

Claims 1-20 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The rejection was made over many grounds which are discussed in turn below.

Claim 1 was rejected because it was alleged that it was unclear how the adjusting steps would take place when a released memory address occurs in a same clock cycle as a request for an available address. That section of the rejection states “[i]t is *improbable* that the adjustment of the memory address pointer takes place within the same clock cycle in which the released memory address is passed of [sic] as a request for an available memory address.” (Emphasis added) While the Office may allege that an occurrence could be improbable, that is not the same as indicating that a limitation is indefinite. Applicants respectfully assert that the recitation in claim 1, that “when a release of a released memory address occurs in a same clock cycle as a request for an available address,” is definite and should not be rejected under 35 U.S.C. §112, second paragraph.

Additionally, the present specification discloses, at page 80, line 21 to page 81, line 1: “This modification includes providing the capability to pass off an address during simultaneous read and write requests. In particular, when an address is released during the same clock cycle in which an address is requested, then the present exemplary embodiment simply passes off the released address to the module requesting an address. As an example of this operation, assuming that a request for an address (a read request) was made during the same clock cycle as a release of an address (a write request), then the cFAP controller is configured to simply pass the released address to the module requesting an address. As such, there is no need to write the released address into the pool and decrement the pointer to indicate that the address is now available, which eliminates multiple clock cycles from the operation.” Thus, Applicants respectfully assert that the above-discussed limitations in claim 1 are clear and are clearly supported by the specification.

Additionally, as discussed above, the Office has alleged that the recitations in claim 1 render that claim impossible. In view of the apparent confusion, Applicants have rewritten claim 1 to point out that certain steps of the method are performed when a release of a released memory address does not occur in a same clock cycle as a request for an available address and other steps are performed when the same does occur. As such, Applicants respectfully assert that it is now clear from claim 1 that the reading, writing and adjustment steps are not performed in the same clock cycle. Reconsideration in view of the changes to claim 1 is respectfully requested.

In addition, the Office Action alleged that the recitation of “passing off” in claim 1 is unclear. Similar rejections of claims 3, 6, 8, 13 and 20 over similar language were also made in the Office Action. Taking all of the rejections together, Applicants respectfully assert that the limitation “passing off” is clear and definite, as discussed in the excerpted portion of the specification. Nevertheless, Applicants have amended claim 1 to more particularly point out that the passing off of the released memory addresses is “in place of the available memory addresses.” Similar changes to 3, 6, 8, 13 and 20 have been made to make it clear that the passing off occurs in place of the memory address that would have otherwise have been supplied. Given these changes to claims 1, 3, 6, 8, 13 and 20, Applicants respectfully assert that the claims are now definite and reconsideration and withdrawal of the rejections of those claims are respectfully requested.

In addition, claim 13 was also rejected for reciting limitations that lack proper antecedent basis. Applicants have amended claim 13 to move the antecedent basis issues and respectfully assert that claim 13 is definite over this ground of rejection as well.


Lastly, the Office also alleges that “passing off” is not generally known in the art and can have various meanings, such as that recited in *Weeks* (U.S. Patent No. 6,363,467). Applicants acknowledge that the limitation could have multiple meanings, but its use in the present claims is clear. Applicants also note that *Weeks* is not prior art to the present invention, based on the filing dates of the provisional application upon which the instant application claims priority.

Applicants also note that the dependent claims were not subject to separate rejections and should be definite in view of the definiteness of the independent claims. In view of the above, Applicants respectfully submit that claims 1-4 and 6-20 are definite and should now be in condition for allowance.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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